

as outlined in Appendix A, attached herewith.

**REMARKS**

Upon entry of the above amendment, claims 1, 6, 9 and 10 will be pending in this application. Applicant respectfully submits that the amendments do not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, entry of the amendments is respectfully requested.

**1. Provisional rejection of claims 1 and 6-10 for obviousness-type double patenting**

The Official Action states that claims 1 and 6-10 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/495,804, claim 6 of copending Application No. 10/507,613, claims 1-13 of copending Application No. 10/513,597 and claims 1-16 of copending Application No. 10/513,598.

Applicant respectfully points out to the Examiner that claims 7-8 have been canceled without prejudice to or disclaimer of the subject matter contained therein, rendering the basis for the rejection of these claims moot.

With regards to claims 1, 6, 9 and 10, applicant respectfully traverses this rejection. In this regard, applicant points out to

the Examiner that this rejection is a provisional rejection and cannot be maintained as each of the four copending applications have yet to be examined.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the provisional rejection of pending claims 1, 6, 9 and 10.

**2. Rejection of claims 1 and 7-15 under 35 U.S.C. § 112, first paragraph**

The Official Action states that claims 1 and 7-15 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

First, applicant respectfully points out to the Examiner that the present application does not contain pending claims numbered 11-15.

Further, applicant respectfully points out to the Examiner that claims 7-8 have been canceled without prejudice to or disclaimer of the subject matter contained therein, rendering the basis for the rejection of these claims moot.

With regards to claims 1, 6, 9 and 10, applicant respectfully traverses this rejection. Applicant has presented an amendment herewith which sufficiently describes "proton pump inhibitor" as those proton pump inhibitors which are "selected from the group

consisting of 5-difluoromethoxy-2-[(3,4-dimethoxy-2-pyridinyl)methylsulphanyl]-1H-benzimidazole (INN: pantoprazole), (-)-5-difluoromethoxy-2-[(3,4-dimethoxy-2-pyridinyl)methylsulphanyl]-1H-benzimidazole (INN: (-)-pantoprazole) and the pharmaceutically acceptable salts, hydrates, solvates, hydrates of the salts and solvates of the salts thereof". Such a description would convey to a person of ordinary skill in the art that the inventor had possession of the claimed invention at the time the application was filed.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

### **3. Rejection of Claims 1, 6, 7 and 9 under 35 U.S.C. § 102(b)**

The Official Action states that claims 1, 6, 7 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Meier et al. for the following reasons:

Meier teaches that administration of omeprazole, a proton pump inhibitor, that is commercially available as a ready-to-use medicament, in the treatment of asthma, an airway disorder.

### **RESPONSE**

Applicant respectfully points out to the Examiner that claim 7 has been canceled without prejudice to or disclaimer of the subject matter contained therein, rendering the basis for the rejection of this claim moot.

With regards to claims 1, 6 and 9, applicant traverses this rejection. The Examiner has not established a *prima facie* case of anticipation against the presently pending claims.

The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

As amended, claims 1, 6 and 9 are limited to those proton pump inhibitors which are "selected from the group consisting of 5-difluoromethoxy-2-[(3,4-dimethoxy-2-pyridinyl)methylsulphanyl]-1H-benzimidazole (INN: pantoprazole), (-)-5-difluoromethoxy-2-[(3,4-dimethoxy-2-pyridinyl)methylsulphanyl]-1H-benzimidazole (INN: (-)-pantoprazole) and the pharmaceutically acceptable salts, hydrates, solvates, hydrates of the salts and solvates of the salts thereof". Meier et al. does not in any way disclose these specific proton pump inhibitors required by the presently pending claims.

Further, applicant notes that this limitation is substantially similar in scope to previously pending (and now canceled) claim 8

which was not rejected by the Examiner as being anticipated under 35 U.S.C. §102(b) by Meier et al.

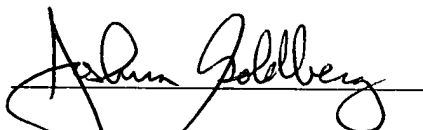
Accordingly, the Meier et al. reference cannot anticipate pending claims 1, 6 and 9 and applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims.

### CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of pending claims 1, 6, 9 and 10. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

Respectfully submitted,  
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